

DETAILED ACTION

1. Claims 24, 33, 34 and 37-39 are pending as amended on 11 January 2008, claims 1-23, 25-32, 35, 36 and 40-44 being cancelled.
2. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office action.

Response to Amendment and Arguments

3. Applicant's amendment, filed 11 January 2008, specifically removing the limitation "about" from the ranges of percentages of the components in the composition in independent claim 24, has been fully considered and overcomes the following:

The rejection of claims 24, 33, 34 and 37-39 are under 35 USC § 102(b) as being anticipated by US Patent 5,691,281 (Ashjian hereinafter) has been withdrawn.

4. Applicant's arguments filed 11 January 2008 have been fully considered but they are not persuasive.

Applicant argues that since the specification discloses a range of potential percentages of the components of the composition the amended endpoints—added in the previous claim amendment—is fully supported and the rejection is improper citing *In Re Johnson and Famham* 558 F.2d 1008, 194 USPQ 187 (1977); however, in *In re Johnson and Famham*, the court found that the applicant could not be limited to preferred embodiments when broader embodiments were disclosed. It is the position of

the examiner that the applicant did not have possession, at the time of the invention, of the blend with the specific ranges recited for the components in the claims, as amended. See *Purdue Pharma v. Faulding Inc.*, 56 USPQ2d 1481, 1487 (Fed Cir. 2000) and MPEP 2163.05 III.

Applicant's arguments regarding anticipation of the instant claims by Ashjian have been considered, but are moot since that rejection has been withdrawn after consideration of the instant amendment.

Applicant reiterates the argument that the single mention of esters in Ashjian is insufficient to anticipate or obviate the esters of the instant claim; however, the examiner maintains the position that it is sufficient as indicated in the previous Office action.

Applicant argues that the examiner has engaged in impermissible hindsight in determining the percentage of esters in the composition; however, it is the position of the examiner that determining the amount of ester that could be added by simple subtraction of the explicitly taught percentages of the other components hardly rises to the level of hindsight and would be well within the ordinary level of skill at the time the invention was made.

Applicant finally argues that the examiner has not presented a *prima facie* case of obviousness in that the invention of Ashjian has not been considered "as a whole"; however, it is the position of the examiner that the admonition that an examiner must consider a reference "as a whole" refers to a requirement that the examiner must consider any "teaching away" in the reference and not a requirement to bodily

incorporate one invention into another. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Claim Rejections - 35 USC § 112

5. Claims 24, 33, 34 and 37-39 stand rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The amended endpoints of the ranges of percentages of the component of the continuous phase of the invert emulsion find no support in the original disclosure or claims. This is a new matter rejection.

Claim Rejections - 35 USC § 103

6. Claims 24, 33, 34 and 37-39 stand rejected under 35 USC § 103(a) as being unpatentable over Ashjian.

Ashjian teaches a method of drilling a wellbore comprising circulating a drilling mud comprising an invert emulsion (Column 1 Lines 5-65), which comprises a base composed of a blend of 5 to 80 weight percent (Column 6 Lines 23-27) of a long chain isomerized olefin of at least 18 carbon atoms (Column 3 Lines 26-41) and 50 to 90 weight percent of n-paraffins, iso-paraffins and cycloparaffins of 10 to 18 carbon atoms

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(Column 3 Lines 51-59 and Column 6 Line 38 – Column 7 Line 6) which may further comprise esters (Column 6 Lines 28-37) which, by difference, may comprise up to 45 weight percent of the blend.

Ashjian does not disclose expressly esters being present in a range of at least 46 weight percent of the blend;

However, Ashjian obviates instant claims since there is no showing in the instant disclosure that the endpoint of the claimed range is critical and because it has been held that when the difference between a claimed invention and the prior art is the range or value of a particular variable, then a *prima facie* rejection is properly established when the difference in the range or value is minor—and certainly the difference between up to 45 weight percent and at least 46 weight percent, a difference of 1.6% of the entire claimed range, can be considered minor. See *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985).

Generally, differences in ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such ranges is critical. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) and *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/TJK/

Patent Examiner, AU 1796

/Randy Gulakowski/

Supervisory Patent Examiner, Art Unit 1796